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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,350	08/30/2006	Gay Joyce Cornelius	102792-599 (11589P1 US)	9754
27389	7590	08/22/2007	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022				ASDJODI, MOHAMMAD REZA
ART UNIT		PAPER NUMBER		
1709				
MAIL DATE		DELIVERY MODE		
08/22/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/597,350	CORNELIUS ET AL.	
Examiner	Art Unit		
Asdjodi M. Reza	1709		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 30 August 2006.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-20 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 07/24/2006.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112 and § 101***

*The following is a quotation of the second paragraph of 35 U.S.C. 112:*

***The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.***

***35 U.S.C. 101 reads as follows:***

***Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.***

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 provides for the use of a composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 6 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

***(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.***

Claims 1, 3-5, 8-16, 18, 19, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vinci et al. (US 6,124,253).

Regarding claim 1, Vinci teaches an aqueous metal cleaning composition, [abstract], containing 5.0 w% to about 50% w% N-alkyl pyrrolidone, and hydrocarbons, [C.10, L.5-10], and water, [C.10, L.40-50].

Vinci teaches every limitation except the exact w% of water and hydrocarbon. Noteworthy is the fact that Vinci teaches a varying w% of active ingredient in his cleaning composition being in the range of 20% to 80%, [C.9, L.60-70], which is in comparable range with the instant claim.

With regard to %w of water and hydrocarbon, the experimental modification of this prior art in order to ascertain optimum cleaning conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to optimize the weight ratios of hydrocarbon and water toward achieving the desired performance of the cleaning composition. A *prima facie* case of obviousness may be

rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

Regarding claim 3, Vinci teaches using a hydrocarbon chain length of 9 to 11 carbon atoms in the composition, [C.21, L.50].

Regarding claim 4, marangoni effect, or behavior, is generally due to spontaneous formation of density gradient in solutions containing compounds of different physio-chemical properties, (e.g.; surface tension, temperature effects) and therefore is inherent to this system.

Regarding claim 5, Vinci teaches a cleaning method which was used on soiled material for cleaning, [C.16, L.25-35].

Regarding claim 8, Vinci teaches alkyl-2-pyrrolidone as being N-octyl pyrrolidone surfactant, [C.8, L.20-25 & C.21, L.60].

Regarding claims 9-11, Vinci teaches a hydrocarbon surfactant mixtures comprising carbon chain length of 9 to 11 carbon atoms, [C.3, L.5 & C.21, L.50].

Regarding claims 12 and 13, and 15, Vinci does not teach exact w% of hydrocarbon, 1-alkyl-2-pyrrolidone, and water.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to adjust the amounts of hydrocarbon, 1-alkyl-2-pyrrolidone, and water to optimize the cleaning ability of this composition. Motivation would have been to optimize the concentrations of each component toward more effective cleaning solution.

This motivation becomes more evident in view of the phase diagram for this cleaning composition system.

Regarding claim 14, Vinci discloses a plurality of hydrocarbons present in his composition, [C.23, L.5-10].

With regard to claim 16, Vinci discloses using of electrolytes such as sodium carbonate and sodium bicarbonate in his composition, [C.22, L.40-65].

Regarding claim 18 and 19, the Office realizes that all the claimed effects or physical properties, such as number of phases, are not positively stated by the reference. However, the reference teaches all of the claimed reagents. Therefore, the claimed effects and physical properties (number of liquid phases) would implicitly be achieved by a composition with all the claimed ingredients. If it is the applicant's position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Regarding claim 20, as in claim 4, the self-induced motility of composition is direct consequence of physical and chemical properties of cleaning composition's constituents and therefore is considered implicit to the system.

Claim 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vinci et al. (US 6,124,253) as applied to claims 1 above and further in view of Silvester et al. (6,150,318).

Regarding claim 7, Vinci et al. teaches the basic claimed composition as set forth above. Vinci does not teach, even though apparent, presence of a container or a package with his composition. However Silvester, teaches use of a plastic aerosol container, [C.6, L.45-50]. Vinci and Silvester are analogous art because they are from the same field of endeavor in relation to cleaning composition. At the time of invention, it would have been obvious to a person of ordinary skill in the art to prepare a container or a package for storing the cleaning composition prior to use and while using it.

Regarding claim 17, Vinci et al. teaches the basic claimed composition as set forth above. Vinci does not teach presence of a bleach in his composition. However, Sivester discloses the use of a bleach in this cleaning composition, and from the range of concentrations of constituents of this cleaner it is quite apparent that the amount of bleach is very minimal. Vinci and Silvester are analogous art because they are from the same field of endeavor in relation to cleaning composition. At the time of invention, it would have been obvious to a person of ordinary skill in the art to add 1% by weight of a bleach to prepare the cleaning solution with an added stain removing effect.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Reza Asdjodi whose telephone number is 571-270-3295. The examiner can normally be reached on Monday-Friday 8:00-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. Reza Asdjodi,  
08-16-07



MARK EASHOO, PH.D.  
SUPERVISORY PATENT EXAMINER

